

REMARKS

In response to the Official Action of May 2, 2008, claims 1, 18 and 19 have been amended.

Claims 1, 18 and 19 have further been amended to clearly recite that the retrieved personal information data can be output via the output module. Support for this amendment in the application as filed at page 5, lines 30-34.

Claim Rejections- 35 U.S.C. § 103

At page 2 of the Official Action, claims 1-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Brinkman et al. (US 2005/0120866, hereinafter Brinkman) in view of DiMaria (US 5,995,014).

With respect to claims 1 and 15-19, it is asserted by the Examiner that Brinkman discloses an apparatus comprising a central processing unit, interface means for providing access to a memory area for storing personal information data of the owner of the electronic device, a user interface having at least input means for inputting operating commands and output means for outputting information data, locking means for locking the electronic device to prevent unauthorized use thereof if activated, and retrieving means for operating the electronic device to retrieve the personal information data stored in the memory area, even if the locking means are activated. Reference is made to paragraph [0071]. It is further stated that Brinkman fails to disclose a memory that stores personal information data of an owner and that the retrieving module is connected to an input module of a processing unit for operating upon receipt of a command, but, these features are disclosed by DiMaria, with reference made to column 5, line 63-column 6, line 4. Therefore, it is asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two references. Applicant respectfully disagrees.

Brinkman is directed to a computing device to allow for the selection and display of a multimedia presentation of an audio file to a user. An interface device couples the musical instrument to the computing device by performing analog-to-digital conversion of the musical instrument's analog audio signal so as to create a digitized audio signal. The

computing device includes a communication device and a processor and the communication device transmits a user's request for the selection of a musical piece to a server. In turn, the communication device receives a session file associated with the musical piece from the server and the processor processes the session file such that the computing device presents a multimedia presentation of the audio file to the user (Brinkman, Abstract).

As seen in Figure 3d-2, a user key 387 associated with a serial number 386 of an interface device 106 (see Figure 1) is used by a security logic 380 to authenticate the interface device to a server 104. In addition, a memory key 389 is used by the security logic 380 to initially unlock the secure memory 379 (Brinkman, paragraph [0071]). Although the Office does not specifically enumerate what elements in Brinkman correspond to the recited elements in claim 1, applicant's attorney believes that the recitation in paragraph [0071] of the use of the memory key 389 to initially unlock the secure memory is being relied upon by the Office.

DiMaria discloses a method and an apparatus for upgrading an existing personal control system. The upgrade is achieved by replacing the personnel data input of an existing personal control system with a biometric interface device capable of reading physical characteristic and an access control signal in the format of the existing personnel control system (DiMaria, Abstract).

In one embodiment of the invention of DiMaria, encoded identification information, personal code, and a generated personal characteristic pattern are required to gain access to a controlled area (DiMaria, Figures 9A-9C and column 5, lines 63-67). An identification document, containing personal identification information, is detected by a card reader in a terminal and read to obtain encoded identification information (DiMaria, column 5, lines 53-56). Then, a personal code (such as a personal identification number or PIN) is requested, and if a code is detected, the system requests a personal characteristic, which can be detected by a scanner (such as an epidermal topographical scanner or an eye scanner), so that a personal characteristic pattern can be generated (DiMaria, column 3, lines 55-57 and column 5, lines 43, 56-61). If the encoded identification information, personal code and generated personal characteristic pattern

does not match the identification information, code and personal characteristic information retrieved from the memory unit, access is denied (DiMaria, column 5, lines 63-67).

The apparatus of claim 1, as amended, comprises a retrieving module operatively connected to said input module and said processing unit for operating the apparatus upon receipt of at least one operating command so as to retrieve the personal information data stored in the memory area so that the personal information data can be output via said output module, even if the locking module is activated. It is clear that at least this feature of claim 1 is not disclosed by either Brinkman or DiMaria.

As stated at page 2, lines 32-35 of the application as filed, it is an object of the present invention to provide an apparatus that can be operated by any third people without any authorization; but only to retrieve personal information about the owner of a device easily. Therefore, it is possible for a third person, e.g. a first-aid attendant, to get information about the owner of the apparatus by retrieving information data from the device in case that the owner is disabled to help her/himself due to an accident or medical emergency (Application as filed, page 3, lines 20-24). The third person can retrieve and access the personal information data even if the locking means are activated and cannot be deactivated by the third person (Application as filed, page 6, lines 9-17).

Neither Brinkman nor DiMaria disclose or suggest retrieving personal information data stored in the memory area so that the personal information data can be output via an output module, even if the locking module is activated.

In Brinkman, the components of the security device described in paragraphs [0069]-[0072], are utilized to uniquely identify the interface device to the server such that access to the server is only granted to a user operating with an authorized interface device, to protect against unauthorized duplication of licensed material (Brinkman, paragraph [0069]). There is no disclosure or suggestion in Brinkman that retrieved personal information data can be output, so as to be accessible to a third person who would not otherwise have access to the server.

In DiMaria, the invention is directed towards upgrading existing personnel control systems, where typical personnel control applications include: computer center; radioactive or biological danger areas; controlled experiments; information storage

areas; airport maintenance and freight areas, etc. (DiMaria, column 1, lines 8-9, 29-36). Not only does DiMaria not disclose or suggest that retrieved personal information data can be output, so as to be accessible to a third person without access authorization, but given the sensitive nature of the areas accessed by the invention of DiMaria, it would be disadvantageous to provide the owner/authorized user's personal information to a third person without access.

Therefore, because neither Brinkman nor DiMaria disclose a retrieving module operatively connected to said input module and said processing unit for operating the apparatus upon receipt of at least one operating command so as to retrieve the personal information data stored in the memory area so that the personal information data can be output via said output module, even if the locking module is activated, it is respectfully submitted that amended claim 1 is not unpatentable over Brinkman in view of DiMaria, and is in allowable form.

Furthermore, as recently set forth by the US Patent and Trademark Office in the document entitled "Examination Guidelines for Determining Obviousness Under 35 USC 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (Fed. Register, vol. 53, no. 195 (October 10, 2007))"

"The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed" (footnote omitted) (Fed. Register p. 57527).

Furthermore, said Guidelines make specific reference to MPEP §§901-901.06(d) and §§2121-2129. Applicant notes that MPEP §901.01(c) relating to analogous art provides that the art to be searched is the invention as claimed as classified but also that analogous arts must be searched regardless of where the claimed invention is classified. Various examples of analogous arts are given such as when searching for a tea mixer it would be permissible to search in the concrete mixer art since they are both in the "mixing" art.

In the present rejection, the art of the two cited references are quite different from each other as noted above. In particular, Brinkman is directed to a computing device to allow for the selection and display of a multimedia presentation of an audio file to a user

while DiMaria is directed to upgrading an existing personal control system by replacing the personnel data input of an existing personal control system with a biometric interface device capable of reading physical characteristic and an access control signal in the format of the existing personnel control system. It is respectfully submitted that it would require an enormous amount of hindsight reconstruction to determine that there is anything in common between these two completely different technical references.

Furthermore, the Office has not established why the two references cited are in fact combinable in the manner relied upon by the Office. In the present rejection, the art of the two cited references is quite different from each other as noted above and the Office has failed to show why any of the rationales annunciated in view of the recent decision of *KSR*, as now set forth in the Guidelines promulgated by the USPTO on October 10, 2007 (Fed. Reg. Vol. 72, No. 195, October 10, 2007, pages 57526-57535), apply to this application.

The seven rationales as specified at page 57529 of the Guidelines are representative of the type of rationale the Office should show for combining references. In fact, the Office has failed to meet any of these rationales since: there is no showing that combining the prior art elements according to known methods would yield predictable results; there is no showing that simple substitution of one element for another would obtain predictable results; there is no showing that there can be use of known techniques to improve similar devices in the same way; there is no showing that applying a known technique to a known device ready for improvement to yield predictable results; there is no showing of an "obvious to try" rationale of choosing from a finite number of identified, predictable solutions with a reasonable expectation of success; there is no showing that known work in one field of endeavor may prompt variations on it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and there is no showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill to modify the prior art reference or combine prior art reference teachings to arrive at the claimed invention.

As such, it is respectfully submitted that the Office has failed to adhere to the examination guidelines as noted above with respect to both the selection of prior art and the analysis of such prior art to show a rationale for obviousness.

Referring now to claims 18 and 19, these claims have been amended to incorporate the feature of outputting the personal information data similar to the amendment of claim 1. As such, it is respectfully submitted that these claims are also in allowable form.

In the Official Action, dependent claims 15-17 are rejected for the same reasons as independent claims 1, 18 and 19. However, the Official Action, does not recite any specific references in Brinkman or DiMaria to the features of these dependent claims. Because these claims are dependent on claim 1, which is believed to be in allowable form, it is respectfully submitted that for at least that reason, they are also in allowable form.

Because claims 2-14 are dependent on claim 1, which is believed to be in allowable form, it is respectfully submitted that for at least that reason, they are in allowable form.

It is therefore respectfully submitted that the present application as amended is in condition for allowance and such action is earnestly solicited.

The undersigned respectfully submits that no fee is due for filing this Amendment. The Commissioner is hereby authorized to charge to deposit account 23-0442 any fee deficiency required to submit this paper.

Respectfully submitted,



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